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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,271	01/02/2004	Andrew J. Dosmann	MSE-2652	1709
71331	7590	03/05/2010		
NIXON PEABODY LLP 300 S. Riverside Plaza, 16th Floor CHICAGO, IL 60606-6613			EXAMINER TURK, NEIL N	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 03/05/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/750,271

Applicant(s)

DOSMANN ET AL.

Examiner

NEIL TURK

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 24-29, 31, 32 and 34-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 24-29, 31, 32 and 34-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Remarks

This Office Action fully acknowledges Applicant's remarks filed on November 17th, 2009. Claims 1-10, 24-29, 31, 32, and 34-43 are pending. Claims 11-23, 30, and 33 have been cancelled.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification lacks antecedent basis for the recitation to the illumination light guide having an outside perimeter, as recited in claims 1, 25, and 34. Examiner acknowledges support for such a recitation as it is found in the drawings; however, the specification is silent to the recitation so as to provide antecedent basis for the claimed limitations. Further, the specification lacks antecedent basis for the limitations of a first illumination end and a second illumination end, as recited in claim 25.

Additionally, the specification lacks antecedent basis for the limitations of newly added claims 35 and 36. Examiner asserts that figure 4 appears to show a square cross section comprising four sides that define an outside perimeter of the light guide 18, but the specification does not provide antecedent basis for the limitations of claims

35 and 36 and the drawings only appear to provide basis for a square cross-section of four sides.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10, 24, 42, and 43 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a format for optical analysis as recited in claim 1 with the *additional* limitations that the detection guide is disposed approximately parallel to the illumination light guide, and further wherein the format includes an illumination redirection facet between the illumination light guide and the read window, and a detection redirection facet in the light pathway between the read window and the detection guide, does not reasonably provide enablement for the optical format as currently recited in claim 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. First, Applicant's specification does not envision any optical format in which the detection guide is not disposed approximately parallel to the illumination light guide. Secondly, the illumination redirection facet 30 and detection redirection facet 38 are necessary for the format of claim 1, as Applicant's specification does not envision any optical format in which the light may be guided around without the provision of facets 30 and 38 (which correspond to the limitations of claims 2 and 3). Applicant's specification does not

provide broad support to such a format which does not utilize these facets. The specification does not describe an optical fiber or other light-guiding media which is curved and positioned so as to guide the light around absent the facets. Applicant's disclosure is solely directed to the optical format in which the facets 30 and 38 are necessary for redirecting and guiding the light to the detection guide.

Similarly, with regards to **claims 25-29, 31, and 32**, the claims are rejected under 35 USC 112, 1st paragraph because the specification, while being enabling for a format for optical analysis as recited in claim 25 and 29 with the *additional* limitations that the read window is positioned perpendicular to the illumination light guide and the detection guide is positioned approximately parallel to the illumination light guide and including the illumination redirection facet (as discussed above w/ respect to cl. 1) and the detection redirection facet (as discussed above w/ respect to cl. 1), does not reasonably provide enablement for the optical format as currently recited in claim 25. As discussed above with respect to claim 1, Applicant's specification does not provide basis for the embodiment of claims 25 and 29.

Claims 34-41 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a format for optical analysis that four over-illumination redirection facets disposed at one or more angles relative to the input light path, as well as a read window disposed along the light pathway and perpendicular to the illumination light guide and a detection guide disposed along the light pathway and parallel to the illumination light guide, and further including the illumination redirection facet (as discussed above w/ respect to cl. 1) and detection redirection facet (as

discussed above w/ respect to cl. 1), does not reasonably provide enablement for the optical form as currently recited in claim 34. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. Applicant's specification only describes, in constitution with the currently recited limitations of independent claim 34, an optical format which has four overillumination redirection facets 22, 24, 26, and 28. This can be most readily seen in Applicant's pre-grant publication US 2004/0142370 in paragraphs [0018-0023]+, for example. Examiner notes that paragraph [0019] of Applicant's pre-grant publication recites, "More or fewer [overillumination] redirection facets may be employed as required by specific optical formats". This disclosure does not provide the enabling disclosure to such specific optical formats which have more or fewer facets. The disclosure does not provide enabling support to the specific optical format being claimed to be enabled for one, two, three, five, and more [overillumination] redirection facets, as the embodiment of claim 34 is only disclosed and described with respect to four overillumination redirection facets. Applicant's claims are drawn to the specific optical format which requires four overillumination redirection facets. Examiner further notes that paragraph [0025] describes, in relevant part, "...In addition to the components described above, FIG. 3 shows one overillumination redirection facet 28 adapted to redirect reference beam 46." However, such a disclosure, even if taken to read on an optical format with only one overillumination redirection facet (the disclosure recites "In addition to the components described above" which appears to include the other three facets 22, 24, 26), such an

embodiment as described here is not commensurate with the current limitations recited in claim 34 and thereby does not provide enabling disclosure to the case where one overillumination redirection facet is utilized. Additionally, as discussed above with respect to independent claims 1, 25, and 29, Applicant's specification only envisions optical formats in which the read window is disposed along the light pathway and is perpendicular to the illumination light guide, and the detection guide is disposed along the light pathway and disposed approximately parallel to the illumination light guide, and further wherein a illumination redirection facet and detection redirection facet are utilized to redirect and guide the light from the input, across the read window, and back out the detection guide.

Claims 35 and 36 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a light guide that has a square cross-section comprising four sides that define an outside perimeter, does not reasonably provide enablement for a polygonal cross-section comprising a plurality of sides that define an outside perimeter. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. Applicant's drawings in figure 4 show a light guide 18 with a square cross-section that has four sides defining an outside perimeter thereof, but Applicant's specification does not provide basis for a light guide having any sort of polygonal cross-section comprising a plurality of sides that define the outside perimeter.

Response to Arguments

Applicant's arguments filed November 17th, 2009 have been fully considered but they are not persuasive.

With regard to the objection of the specification as not providing antecedent basis for claim recitations (as outlined above in the body of the action), Applicant traverses the objection.

Applicant argues that the specification provides full support for the claim limitations identified above and a person of ordinary skill in the art would understand what is meant by each of the limitations.

Examiner argues that the objection appears to be misunderstood. An objection to the specification as lacking antecedent basis for the above-identified claim recitations means that the specification literally does not include those words/phrases in a relevant portion of the description. Examiner argues that the above-identified limitations are not present in the specification. Examiner asserts that Applicant should amend the specification in a manner which does not include new matter to the specification, while incorporating the above-identified limitations. Examiner asserts that the objection is not directed toward a question of one's understanding of the definitions of the above-identified limitations.

With regard to claim 31 rejected under 35 USC 112, 1st paragraph, Applicant traverses the rejection. Applicant argues that claim 31 has been amended to recite that the read window is disposed approximately perpendicular to a longitudinal axis of

the illumination light guide. Examiner asserts that base independent claim 29 is maintained rejected under 35 USC 112, 1st paragraph, and as such, dependent claim 31 remains rejected as well.

With regards to claims 1-10, 24-29, 31, 32, and 34-43 rejected under 35 USC 112, 1st paragraph, Applicant traverses the rejection.

Applicant argues that the focal point of any enablement analysis is whether the specification, as filed, supports that which is set forth in the claims, not whether the specification supports that which is not set forth in the claims.

Initially, Examiner asserts that this is not an enablement rejection but a *scope of enablement* rejection, as outlined in the body of the action. Additionally, Examiner argues that the claims are enabled with the additional elements added, as discussed above in the body of the action.

Secondly, with respect to the above-noted argument by Applicant, Examiner asserts that the claims, as currently recited, are not enabled by the specification. In the rejection, Examiner has pointed out the additional necessary elements that would provide for a claim that reads on an enabled embodiment.

Examiner asserts that the claims as currently recited are far broader than what is enabled by the specification. Examiner has pointed out instances in the negative so as to show that the specification only provides basis for the particular elements deemed necessary (the "*with the additional limitations*" recited in the rejection) for providing an

enabled embodiment. Applicant's disclosure does not provide basis for one of ordinary skill in the art to make and/or use the currently claimed formats.

In addition, and in a positive-manner of inclusion, Applicant's disclosure does not provide any teaching(s) which provide one of ordinary skill in the art to make/use the additional embodiments encompassed by the claim language of the above claims. Examiner asserts that the supporting remarks provided in the rejection of the claims under 35 USC 112, 1st paragraph scope of enablement rejection, have been provided as showings for the specification's lack of teaching to provide one of ordinary skill in the art to be able to make/use the additional embodiments encompassed by the currently recited claims. Applicant's specification is limited to the embodiment discussed above, and is not enabled for the various optical formats encompassed by the current claims.

Examiner further argues that Applicant has not provided any arguments or showings from Applicant's specification which show the basis for the current claims. Applicant has provided only generic arguments that the specification as originally filed, fully supports the breadth of the current claims. To this end, as discussed above, Examiner disagrees, and asserts that the specification does not provide teachings for one of ordinary skill in the art to envision how to make/use the embodiments encompassed by the current claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEIL TURK whose telephone number is (571)272-8914. The examiner can normally be reached on M-F, 9-630.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NT

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797